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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,627	03/23/2001	Peggy M. Stumer	2001P05288US	7108

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Siemens Corporation
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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,627

Applicant(s)

STUMER ET AL.

Examiner

Melur Ramakrishnaiah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-10, 17-20 is/are rejected.
- 7) ☐ Claim(s) 4-7 and 11-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 8, and 17-20, are rejected under 35 U.S.C 102(a) as being anticipated by Needham et al. (GB 2349774 A, pub date: 11-8-2000, hereinafter Needham).

Regarding claim 1, Needham discloses a method for processing emergency call made from behind a PBX/MLTS coupled to a private network, the method comprising the steps of: within the PBX/MLTS determining whether dialed digits represent an emergency number, and assigning priority within PBX/MLTS to a call determined to be an emergency call, such that call takes priority over other calls in traversing the private network (reads on PBX and associated ISDN trunks) before reaching the public network trunk (24, fig. 1, page 3 lines 17-33, page 4 lines 1-6, lines 27-32).

Regarding claim 8, Needham discloses an apparatus for processing an emergency call from behind a PBX/MLTS coupled to a private network, the apparatus comprising : means within the PBX/MLTS for determining whether dialed digits represent an emergency number, and means for assigning priority within PBX/MLTS to a call determined to be an emergency call, such that call takes priority over other calls in traversing the private network (reads on PBX and associated ISDN trunks) before reaching the public network trunk (24, fig. 1, page 3 lines 17-33, page 4 lines 1-6, lines 27-32).

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Regarding claims 17-19, Needham further teaches the following: private network includes a second PBX/MLTS (reads on ISDN trunks connecting the PBX (18) to PSTN lines, page 3 lines), processing emergency call in the private network based on the assigned priority (page 4 lines 27-32).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3 and 9-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Needham in view of Tanaka et al. (US PAT: 6,243,442, hereinafter Tanaka) and Hoskinson et al. (US PAT: 5,339,351, hereinafter Hoskinson).

Regarding claims 2-3, and 9-10, Needham does not teach the following: storing a port number for each device/trunk in the PBX/MLTS, and determining from which port the emergency call originated and associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point the ELIN associated with the port from which emergency call originated.

However, Tanaka teaches the following: storing a port number for each device/trunk in the PBX/MLTS, and determining from which port the emergency call originated (col. 9 lines 63-67, col. 10 lines 1-30); and Hoskinson discloses a

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emergency response system which teaches the following: associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point the ELIN associated with the port from which emergency call originated (col. 7 lines 18-20, fig. 3, col. 7 lines 56-68, col. 8 lines 1-4).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Needham's system to provide for the following: storing a port number for each device/trunk in the PBX/MLTS, and determining from which port the emergency call originated and associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point the ELIN associated with the port from which emergency call originated as this arrangement would enable the operator at the emergency response center to dispatch necessary help to the emergency caller as is well known in the art.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Needham in view of Tanaka.

Regarding claim 20, Needham discloses a method for processing an emergency call made from behind a PBX/MLTS coupled to a private network, the method comprising the steps of: with in PBX/MLTS determining whether dialed digits represent an emergency number, assigning priority within the PBX/MLTS to a call determined to be an emergency call, such that the call takes priority over other calls in traversing the

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private network (reads on PBX and associated ISDN trunks) before reaching a public trunk network (24, fig. 1, page 3 lines 17-33, page 4 lines 1-6, lines 27-32).

Needham differs from claim 20 in that he does not teach the following: storing a port equipment number for each device/trunk in the PBX/MLTS.

However, Tanaka teaches the following: storing a port equipment number for each device/trunk in the PBX/MLTS (fig. 4, col. 9 lines 63-67, col. 10 lines 1-30)

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Needham's system to provide for the following: storing a port equipment number for each device/trunk in the PBX/MLTS as this arrangement would enable the operator at the emergency response center to dispatch necessary help to the emergency caller as is well known in the art.

6. Claims 4-7 and 11-14, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed on 7-6-2004 have been fully considered but they are not persuasive.

Rejection of independent claims 1 and 8 under 35 U.S.C 102(a) as being anticipated by Needham et al. (GB 2349774 A, pub date: 11-8-2000, hereinafter Needham): Regarding rejection of claims 1, 8, Applicant argues on page 5 of his response that "Applicants respectfully submit that Needham does not teach or discloses a PBX/MLTS that is coupled to one or more private networks nor does it discloses

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assigning a priority to the emergency call in traversing the private network". Contrary to Applicant's interpretation of Needham reference, Needham does teach PBX/PMLTS (16, fig. 1) that is coupled to one or more private networks (for example Trunks 26A-26C connecting the PBX (16) to public switched network (PSTN 24, page 3 lines 27-31, page 4 lines 27-29), and further Needham teaches assigning priority to call if it is 911 call (page 3 lines 17-19, page 4 lines 1-5). Needless to say, Needham gives priority to 911 calls by generating busy signal to other calls when system cannot handle other calls (page 4 lines 1-5).

Pages 6-7 of Applicant's response to final rejection quotes profusely from Needham reference and in particular applicant argues on page 7 last paragraph that "The ISDN trunk lines the Examiner contends define a "private network" are in fact between PBX 16 and public network PSTN 24, and, are not part of the private network as defined in the present invention and therefore do not define the claimed private network. Needham, a fortiori, also does not teach or suggest the prioritizing of calls within the private network". Notwithstanding the applicant's contention to the contrary, Needham, as explained above, teaches PBX/MLTS (16) that is coupled to one or more private networks (for example Trunks 26A-26C connecting the PBX (16) to public switched network (PSTN 24, page 3 lines 27-31, page 4 lines 27-29). Further Needham teaches prioritizing of 911 or emergency calls within the private network (page 3 lines 17-19, page 4 lines 1-5).

Rejection of claims 2-3, 9-10, under 35 U.S.C 103(a) over Needham in view of Tanaka et al. (US PAT: 6,243,442, hereinafter Tanaka) and Hoskinson et al. (US PAT:

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5,339,351, hereinafter Hoskinson): Regarding rejection of claims 2-3 and 9-10 using the above combination, Applicant argues on page 8 of his response to the final rejection that "Applicants submit that because of the deficiencies in the Needham disclosure as discussed above with respect to claims 1 and 8, and because claims 2-3 and 9-10 depend from claims 1 or 8, claims 2-3, 9 and 10 are believed neither taught nor suggested by the stated combination, and therefore allowable thereover, for at least similar regions". Regarding this, as explained above, Needham clearly teaches the limitations of independent claims 1 and 8 and dependent claims 2-3 and 9-10, are not allowable, since the combination of Needham with Tanaka and Hoskinson teaches the limitations of claims 2-3 and 9-10 as set forth in the office action above.

Applicant in his response to final rejection on pages 8-9 refers to previous office action and his arguments in response to the actions. On page 10 of his response to final rejection, regarding rejection of claims 2-3 and 9-10 under above combination of Needham in view of Tanaka and Hoskinson, Applicant argues that "First as pointed out in the September 24, 2002 response in traversing a similar rejection of 2, 3, 9, and 10 in the August 5, 2002 office Action, the combination of Tanaka and Hoskinson to form the claimed invention is unmotivated". Regarding this, motivation to combine Needham with Tanaka and Hoskinson for rejecting the claims 2-3 and 9-10 is clearly set forth in the office action above. Applicant further argues about combination of Needham with Tanaka and Hoskinson and argues that "such unmotivated dissection and combination is formed only with the benefit of the present invention as claimed and is clearly improper. Applicants respectfully submit that a prima facie case of obviousness has not

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been set forth and these rejection cannot stand". Regarding this, it appears that Applicant is advancing hindsight argument to promote his argument against the rejection using the combination as set forth above. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In light of above explanation, Examiner respectfully submits that a prima facie case of obviousness rejection has been set forth for claims 2-3 and 9-10 in the office action as set forth above.

In light of the above explanation, rejection of claims 1-3, and 8-10 is maintained

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on M-F 6:30-4:00; every other F Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703)305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melur Ramakrishnaiah
Primary Examiner
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